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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/135,154	08/17/1998	T. ALLAN HAMILTON	CLB5-B73	8963

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EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT PAPER NUMBER

2635

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/135,154

Applicant(s)

HAMILTON, T. ALLAN

Examiner

Brian A. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

EXAMINER'S RESPONSE**Status of Application**

In response to the applicant's amendment received on 9/28/05. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 50-60 remain unpatentable for the reasons set forth in this office action:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 50-60 are rejected under 35 U.S.C. 103(a) as obvious over Kohler (U.S. 5,115,236) and the IRDA specification as discussed by the applicant on page 3 of the specification and the EP publication Selin (EP 0772307) and Kulha (5973611).

Kohler teaches a device (Fig. 2) for reducing power consumption in infrared-enabled appliances having power supply means and transceiver system means forming a circuit including switch means (Col. 1, lines 7-28 and Col. 2, lines 30-54), comprising: (wake-up) signal receiver (RC receiver in Fig. 2) and power actuator module (control voltage output 41 in Fig. 2), said module configured to recognize incident Ir discovery signals and responsively activate said switch means (Col. 3, lines 53-68 through Col. 5, lines 1-22). Kohler

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teaches an infrared receiver (Fig. 2) and discovery signal detection circuitry configured to recognize the power level of the infrared "discovery signals" incident to said receiver and emit a power-up signal to said switch means (Fig. 2; Col. 4, lines 28-56). Kohler teaches that the power-up (message) signal can be instigated by user input (keyboard 8 in Fig. 3) via the transmitter portion of the transceiver system (Col. 5, lines 30-48). It is noted the Kohler device requires interpretation to determine if a wake up signal is being received. Therefore the received signal is interpreted in order to determine if a wake up signal has been received. The applicant admits that the IRDA standard discovery signal is used as a wake up signal. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an IRDA discovery signal to control the wake up elements of the Kohler communication system.

In an analogous art, Selin shows a communication device that uses a sleep mode to reduce power consumption in the devices. Selin uses a specially coded signal or sequence to wake up a receiving communication unit. See col. 4 lines 45-55 and col. 9 lines 32+. Selin teaches that most of the activities of the device are switched off in order to conserve power. In the above system, the receiver (and a portion of the processor that recognizes the wake up signal) must remain on to enable waking up of the device. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have switched off the claimed elements as unessential elements while providing power to the receiver and associated wake up discovery processor as suggested by

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Selin in the Kohler system because such would provide improved power conservation.

In an analogous art, Kulha shows a signal processor that is used to received a signal and generates a wake up or power up signal when the appropriate over the air signal is received. By providing a sleep mode the receiver advantageously saves power. By providing the processor with a portion that remains awake to receive wireless signals and wake up the rest of the processor the device can be provided in a single, simple circuit thus reducing space required on the circuit board. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the sleep mode detecting section of a processor as shown by Kulha to reduce power consumption and reduce the space taken up by the circuitry of the IR communication device discussed above.

2. Claims 50-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nykanen (5706110) and Kulha (5973611).

Nakanen shows a bi-directional IR communication device that includes bi-directional interface with the user, see figure 1 and description of IRDA.

Nakanen inherently processes the IR signals received, and inherently includes a controller to control the operation of the transmitter, receiver and power supply.

Nakanen shows a power management device, which in a standby mode provides operating power to only a portion of the circuit needed to receive and decode a wake up signal, while switching off the additional circuits. See col. 4 lines 1-15.

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Nakanen does not expressly show a battery as the power supply, but one of ordinary skill in the art at the time of the invention would have found it obvious to use a battery as the power supply in the Nakanen device in order to make the device portable or mobile.

In an analogous art, Kulha shows a signal processor that is used to receive a signal and generates a wake up or power up signal when the appropriate over the air signal is received. By providing a sleep mode the receiver advantageously saves power. By providing the processor with a portion that remains awake to receive wireless signals and wake up the rest of the processor the device can be provided in a single, simple circuit thus reducing space required on the circuit board. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the sleep mode detecting section of a processor as shown by Kulha to reduce power consumption and reduce the space taken up by the circuitry of the IR communication device discussed above.

Response to Arguments

Applicant's arguments filed 9/29/05 have been fully considered but they are not persuasive. First it is not clear whether the applicant's declarations are an attempt to show solving a long felt need or commercial success. Since the applicant has not identified a long felt problem and when it was identified these declarations fail to meet the requirements of MPEP 716.04 that states:

Establishing long-felt need **requires objective evidence that an art recognized problem existed in the art for a long period of time without solution.** The relevance of long-felt need and the failure of others to the issue of obviousness

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depends on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967) ("Since the alleged problem in this case was first recognized by appellants, and others apparently have not yet become aware of its existence, it goes without saying that there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others skilled in the art who unsuccessfully attempted to solve a problem of which they were not aware."); *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention achieved the desirable result of reducing inventories, there was **no evidence of any prior unsuccessful attempts to do so.**).

Since the declarations do not comply with the long felt need sections of MPEP 716, it is assumed that the declarations are attempting to point to commercial success as a secondary consideration, which falls under MPEP 716.03. The applicant makes multiple arguments relating to an issue that no other company has ever made such a device with the 'claimed' features. This argument relates to long felt need and does not weigh in on a discussion of commercial success.

Regarding the 132 Declaration of Grace, the examiner maintains that the declaration provides no factual evidence of nexus. The applicant points to a customer discussion as a rebuttal. First it is noted that one customer is not a very large percentage of the million dollars accounted for in the Declaration. Additionally, it is pointed out that the customer desired one more expensive Zilog product over another Zilog product. There is no evidence that the only difference between these products is the battery saving feature discussed. There is plainly no evidence that shows a nexus between the claimed invention and the sales figures that would point to the conclusion the applicant submits. The applicant

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disagrees with the examiners finding that there is a lack of nexus between the commercial success and the claimed invention. MPEP 716.03 states:

Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate **in* scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.).

An affidavit or declaration attributing commercial success to a product or process "constructed according to the disclosure and claims of [the] patent application" or other equivalent language **does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold corresponds to the claimed invention**, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. *Ex parte Standish*, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

The Grace Declaration is hearsay evidence, in that it is what one person heard another person state. In any way it is neither factual nor objective as to the pertinent question. There is no comparison between the product represented by the claims and other products. There is no evidence supporting any contention that the product differed from the other products by only the claimed subject matter. The applicant argues that this is not an issue, but it is. If the product with the claimed subject matter sold because it also had a larger transmission power,

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then the mere sale of it over another lesser product cannot be used as evidence that the reason for the sales was the claimed subject matter.

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

In *ex parte* proceedings before the Patent and Trademark Office, **an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight.** See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (an opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Compare *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (In civil litigation, a patentee does not have to prove that the commercial success is not due to other factors. "A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence.").

Additionally, the applicant has merely pointed to gross sales figures which are not substantive enough to show commercial success.

Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to

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what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

The applicant then points to a second declaration by McIntosh. Upon careful review of this declaration the examiner is still unconvinced of commercial success. First there are hints of long felt need issues in the declaration, yet the declaration fails to provide the required points discussed above for a long felt need consideration. The discussion offered by McIntosh offers possible reasons of commercial success, still no factual evidence as to market share.

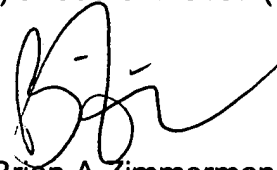
Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy in accordance with 37 CFR 1.3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A. Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 571-272-3068. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Brian A. Zimmerman', is positioned above the printed name.

Brian A Zimmerman
Primary Examiner
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BAZ